


Doc Code: AP.PRE.REQ

PTO/SB/33 (01-09)
Approved for use through 02/28/2009. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		0033-0971PUS1	
	Application Number	Filed	
	10/519,477-Conf. #2658	December 30, 2004	
	First Named Inventor Hiroaki HAMADA et al.		
	Art Unit	Examiner	
	2622	A. R. Hsu	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>52,327</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p> Signature</p> <p><u>Catherine M. Voisin</u> Typed or printed name</p> <p><u>(703) 205-8000</u> Telephone number</p> <p><u>May 8, 2009</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

Docket No.: 0033-0971PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hiroaki HAMADA et al.

Application No.: 10/519,477

Confirmation No.: 2658

Filed: December 30, 2004

Art Unit: 2622

For: MOBILE PHONE EQUIPMENT

Examiner: A. R. Hsu

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Madam:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed concurrently with a Notice of Appeal.

The review is being requested for the reasons set forth on the attached four (4) Sheets.

The Examiner has made clear errors in interpreting and applying the appropriate tests and applying the prior art in rejecting claims 1-13 under 35 U.S.C. §103(a) as being unpatentable over Sogabe (USP 7,176,964) in view of Umeyama (U.S. Patent Application Publication No. 2002/0057473).

**The Examiner has Failed to Establish Prima Facie Obviousness
by Failing to Provide References that Teach or Suggest All of the Claim Elements,
Including “an image playback unit for continuously and simultaneously displaying on said
display unit the plurality of said original image data while the continuous photographing
function is set.”**

The Examiner has made clear error in considering certain claim elements are taught by an unduly broad interpretation of the teachings of the cited art. With regard to claim 1, the Examiner asserts that the combination of the teachings of Sogabe and Uymeyama are sufficient to teach all of the elements as set forth in the claim. Applicants maintain that the teachings of the cited are insufficient to render the pending claims obvious.

Claim 1 requires a photographing unit for converting incident light into an electric signal and outputting as image data a plurality of original image data captured during a continuous photographing function by a single operation of a shutter button; a first image data storage unit for temporarily storing the plurality of original image data obtained with the continuous photographing function of said photographing unit; a display unit for displaying said original image data; and an image data playback unit for continuously and simultaneously displaying on said display unit the plurality of said original image data stored in said first image data storage unit, while the continuous photographing function is set, until input from a user is received.

In support of her rejection of claim 1, the Examiner asserts that Sogabe discloses all of the claim elements, except the apparatus being a mobile telephone. The Examiner relies on the teachings of Umeyama to cure the deficiencies of the teachings of Sogabe. Applicants respectfully disagree that the teachings of the cited references are sufficient to render the pending claims unpatentable.

The disclosure of Sogabe is directed to an electronic still camera having a continuous pickup mode and a display unit for displaying a frame image in a display manner specialized in the pickup mode in which the frame image is generated (Abstract).

Specifically, Sogabe discloses an electronic camera having a reproduction/image pickup mode selection switch 53 and a mode selection switch 54. Mode selection switch 54 cyclically changes between Reproduction Modes I and II if switch 54 is in the reproduction mode. Mode selection switch 54 cyclically changes between Continuous Pickup Mode, Shutter Change Mode and Single Pickup Mode when switch 54 is in the image pick up mode (see col. 4, lines 15-32).

Sogabe discloses in col. 6, lines 21-46 as follows:

FIG. 5 is a flowchart showing a first half of the processing of the camera 1 set in the Reproduction Mode I. Specifically, if the Reproduction Mode I is selected by the mode selection switch 54 after the camera 1 is set in the reproduction mode by the image pickup/reproduction switch 53, the control unit 7 outputs a control signal and causes the reading of the latest image data file stored in the storage medium 3. The read image data file is reproduced into an image data by the image processing unit 4 and an image corresponding to the tag information file in the image data file is sent to the display unit 6 (Step #100). Specifically, the display unit 6 displays the image in the normal display format shown in FIG. 2A if no continuous frame information is included in the image data file. **On the other hand, if the continuous frame information is included in the image data file, the display unit 6 displays images in the 1/4 or 1/9 multi-display format shown in FIG. 2B or 2D.** Here, a value representing the frame number of the image displayed in the display unit 6 is substituted for a reproduced frame number "m" used in the following processing.

Thereafter, it is discriminated whether the image pickup/reproduction switch 53 has been switched to set the image pickup mode (Step #105). If the discrimination result is in the affirmative, the processing of this flowchart ends. It should be noted that a flowchart of the image pickup mode is executed thereafter. (Emphasis added)

The Examiner asserts that Sogabe discloses "an image data playback unit for continuously and simultaneously displaying on said display unit the plurality of said image data stored in said first image data storage unit, while the continuous photographing function is set, until input from a user is received." The Examiner relies on the highlighted portion noted above to support this assertion. Applicants respectfully disagree with the Examiner's interpretation of the teachings of Sogabe.

The disclosure above regarding Fig. 5 clearly recites the situation where the camera is in a reproduction mode via switch 53, not in an image pickup mode (or the continuous pickup mode). Sogabe discloses that the display of Fig. 2B or 2D may display a plurality of images that were captured during the continuous pickup mode. However, Sogabe clearly discloses that these displays are made during the reproduction mode.

The Examiner may be interpreting Sogabe to teach displaying the plurality of images captured during the continuous pickup mode even after the mode is switched via switch 53 to the image pickup mode in Step 105 of Fig. 5. In other words, the Examiner may be interpreting Sogabe to teach displaying the images on the display even after the mode has been changed via switch 53 to an image pickup mode. Sogabe appears to be silent with regard to Fig. 5 about what happens to the display when the mode switch is changed from the reproduction mode to the image pickup mode.

However, col. 3, lines 1-4 teaches the electronic still camera including a display unit 6 for displaying an image to be picked up or a reproduced image. As such, Applicants maintain that this teaching supports a proper interpretation that when the mode is changed from a reproduction mode to an image pickup mode via switch 53, the images in the reproduction mode are no longer displayed and the image to be picked up is displayed.

As such, when considering a proper interpretation of Sogabe, Sogabe fails to teach or suggest an image playback unit for continuously and simultaneously displaying on said display unit the plurality of said original image data **while the continuous photographing function is set.** As Umeyama fails to cure the deficiencies of the teachings of Sogabe, Applicants maintain that claim 1 is patentable over the references as cited. It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2-5 and 8-10 are allowable for the reasons set forth above with regard to claim 1 at least based on their dependency on allowable claim 1. It is further respectfully submitted that claims 6 and 12 similarly recite the claim elements discussed above with regard to claim 1, claims 6 and 12, together with claims dependent thereon, are patentable over the references as cited.

Conclusion

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: May 8, 2009

Respectfully submitted,

By 

Catherine M. Voisinet

Registration No.: 52,327

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicants